

### **REMARKS/ARGUMENTS**

Reexamination and reconsideration of this application, withdrawal of the rejections, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the above amendments and remarks that follow.

Claims 4, 8, 9, 12-14, 20, 24-27, 33, 36-40, and 42-46 are pending in the application. Claim 27 has been amended to incorporate the subject matter of claim 41, which is now cancelled. Claim 42 has been amended to correct dependency. Applicants respectfully submit that no new matter is introduced by these amendments.

Claims 4, 8, 9, 13, 14, 20, 24-27, 33, 36-40 and 46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jupe *et al.* (WO 02/069745 A1) in view of Tatenos *et al.* (U.S. 4,889,144) and Applicants' admitted prior art. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jupe *et al.*, Tatenos *et al.*, and Applicants' admitted prior art as applied to claim 27, and further in view of Jones *et al.* (U.S. 5,307,823). Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jupe *et al.*, Tatenos *et al.*, as applied to claim 27, and further in view of Berger (U.S. 4,046,063). Applicants respectfully traverse these rejections as applied to the amended claim set.

It is noted that the subject matter of claim 41 is now incorporated into independent claim 27. Since claim 41 was not implicated in these rejections, it is respectfully submitted that the rejections are now rendered moot. Applicants note that this amendment is made to expedite prosecution, and not in acquiescence to the propriety of the rejection as presented.

Claims 27 and 41-44 stand rejected on the ground of a nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending U.S. Application No. 10/675,937 in view of Jupe *et al.* (WO/ 02/069745 A1) and Tatenos *et al.* (U.S. Patent No. 4,889,144). Applicants respectfully traverse this rejection.

Applicants respectfully submit that, in promulgating the present rejection, the Examiner has lost sight of the proper rationale underlying an obviousness-type double patenting rejection. As pointed out in MPEP 804(II)(B)(1), an obviousness-type double patenting rejection is only appropriate when the claimed subject matter is **not patentably distinct** from the subject matter

claimed in a commonly owned patent (or pending application), or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3), when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

In making an obviousness-type double patenting rejection, each claim is an entity which must be considered as a whole. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272 (Fed. Cir. 1992). Claims must be read as a whole in analyzing a claim of double patenting. *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983). It is respectfully submitted that the differences between the pending claims of the present application and the claims of the copending application, when those claims are considered as a whole, are clearly distinct enough to avoid a finding of obviousness-type double patenting.

As acknowledged by the Examiner, claim 1 of the copending application (which is now allowed) does not recite the presence of a breakable capsule of any kind. In contrast, all claims of the present invention recite the presence of a breakable capsule comprising a gelatin shell and a liquid payload that comprises a flavoring agent and a triglyceride diluting agent. Still further, all claims of the present invention recite that the breakable capsule is located in a compartment in a section of filter material positioned distal from the tobacco rod and therefore downstream from the claimed adsorbent material.

Despite the lack of a capsule of any kind in claim 1 of the copending application, the Examiner opines that the present invention is merely an obvious variant, pointing to the Jupe and Tateno references as proving this point. However, as admitted by the Examiner, Tateno fails to teach capsules with gelatin shells and triglyceride diluting agents. Instead, Tateno suggests completely different diluting agents (certain powder materials) and shell materials (polysaccharides).

In addition, the Jupe reference actually teaches away from the filter arrangement set forth in the present claims as apparently acknowledged by the Examiner. The Jupe patent suggests that the tobacco end filter component should have the lowest particulate RTD of all filter components. Accordingly, combining Jupe with the claims of the copending application is

either untenable because of the diametrically opposed teachings or would result in altering the filter element of the copending application to change the relative particulate removal efficiencies of the two filter segments.

Even if one accepts the motivation of one of skill in the art as explained by the Examiner in the rejection, one would still not conclude that the present claims are merely an obvious variant of the copending claims. The Examiner notes that Tateno would suggest the inclusion of the Tateno capsules within the cavity claimed in the copending application. It is noted that the claimed cavity of the copending application contains adsorbent material and an ion exchange resin and is positioned between two sections of filter material. In contrast, the pending claims recite a capsule positioned in a compartment in the first section of filter material such that the capsule is downstream from the adsorbent material, meaning the capsule is not placed in a central cavity with the adsorbent material. In fact, Tateno expressly suggests combining flavor particles with “destruction-accelerator particles” such as activated carbon in the same compartment so the carbon particles can aid rupture of the flavor particles. Thus, Tateno clearly fails to suggest positioning a breakable capsule in a segment of filter material downstream from adsorbent material as presently claimed. Thus, even if one were to modify the copending claimed filter arrangement with the teachings of Tateno as suggested in the office action, one would not reach the presently claimed invention.

In addition, the present claims recite that the filter segment containing the capsule comprise two parts: an inner central portion defining the cavity and an annular outer portion surrounding the central portion. This is shown in Fig. 10 of the present application as inner element 58 surrounding cavity 60 and annular element 56 surrounding element 58. In contrast, Tateno does not show two separate sections of filter material positioned in an annular relationship surrounding a cavity. The Examiner states that Figs. 1 and 3 of Tateno illustrate such a structure, but the undersigned must respectfully disagree. The cited figures of Tateno mention only a “filter tip 1” having a “space 2a” therein. Applicants respectfully request that the Examiner point out any discussion in Tateno of a filter segment comprising two sections of filter material, one positioned annularly around the other, with the inner section defining a cavity. Tateno only illustrates a cavity within a single surrounding section of filter material.

Appl. No.: 10/675,584  
Amdt. Dated: December 1, 2010  
Reply to Office Action of September 1, 2010

For at least the reasons noted above, it is not believed that the Jupe and Tatenno references are suggestive of the obviousness of the pending claims in relation to the copending claims. Still further, the Examiner has not shown that issuance of both the present claims and the copending claims would provide unjustified extension of the right to exclude granted by a patent. It is readily apparent that numerous conceivable embodiments of a filter element could be prepared according to the claims of the copending application that would not fall within the scope of the presently pending claims. In fact, even embodiments of the filter element of the copending claims that are modified to include a capsule could be envisioned that would not fall within the scope of the presently pending claims. It is respectfully submitted that there is no reasonable basis for asserting that the differences between the two claim sets are so insignificant that public policy would dictate that one could unjustly extend the patent term of the other.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 09-0528.

Respectfully submitted,

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**ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT &  
TRADEMARK OFFICE ON DECEMBER 1, 2010.**